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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,574	09/18/2000	Daniel I. Flitcroft	032668-026	6529
21839	7590	06/17/2005	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			CUFF, MICHAEL A	
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ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			3627	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/665,574

Applicant(s)

FLITCROFT ET AL.

Examiner

Michael Cuff

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20050112,0113,0422</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority / Information Disclosure Statement / Office response***

1. The examiner is presenting a new rejection based upon reference, US patent 6,422,462 Cohen, which has an effective filing date of March 30<sup>th</sup> 1998. One of the three foreign references, S980223, is dated March 25<sup>th</sup> 1998. Foreign priority has been claimed from this reference, but a copy of this reference is not included in the application. Foreign priority must be perfected with respect to the current claims and reference S980223.

Three additional IDSs have been submitted for consideration.

Applicant has submitted an Appeal brief, dated 3/28/05. The examiner withdraws the previous rejection based on applicant's arguments (at least for claim 1. Claims 21 and 39, for example, do not include the permission of multiple transactions, which is necessary to read over the prior rejection.). While preparing the case for allowance, three references, Cohen (6,422,462), Pitroda (5,884,271) and Filtcroft et al. (6,636,833), surfaced. The Filtcroft et al. reference is of interest for double patenting reasons.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 14, 15, 17, 20, 21, 39, 45, and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 6 of U.S. Patent No. 6,636,833. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference in the claims includes just minor rewording.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-11 and 13-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen.

Cohen shows a credit card system where a customer provides the ordinary credit card number (master number) and verification data and then is provided with a disposable or customized number for limited use. (column 3, lines 44-48) No vendor would ever receive or have access to the user's permanent credit card number (column 4, lines 26-28, means for associating said master credit card with limited use card the connection which cannot be discovered.) Column 7, lines 54-65, show that the limited use card number can be activated and deactivated based on predetermined criterion. (limited use, but including permitting multiple uses) The reference has many different examples of how the customized card could be tailored including combinations of dates of transactions, types of transactions amounts for individual and/or total transactions, etc. on a single card or on multiple cards, can be set as well. (Column 10, lines 31-34) Many cards can be issued for many different uses. New numbers and conditions can be set over the Internet. Column 4, lines 4-6, the user could be provided with credit cards or paper (printing means) with a credit card encoder (encrypted), with an encoding device which attaches to the computer, an or the Internet, or otherwise.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen.

Cohen shows all of the limitations of the claims except for specifying an ATM as a dispensing means

The examiner takes Office that ATMs are used frequently to communicate with credit card companies and that one of ordinary skill in the would include an ATM as a possible computer with Internet access to obtain a new card number in order to better serve customers.

Based on the discussion above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Cohen to include ATMs as one of the "otherwise" choices (from the "computer, an or the Internet, or otherwise".) of computerized communication devices in order to better serve customers.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pitroda shows a system of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (571) 272-6778. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 6/10/05  
Michael Cuff  
June 10, 2005